

REMARKS

Claims 1-2, 6-8, 16-17, 51-56, 58-60, 79-85 and 96 are pending in this application. By this Amendment, claims 1, 6, 7, 16, 51, 54, 56, 59 and 79 are amended, and claim 96 is added. Reconsideration is respectfully requested.

Applicant gratefully acknowledges the courtesies extended to Applicant's representatives at the personal interview conducted on August 13, 2004. The substance of the interview is incorporated into the following remarks which constitute Applicant's record of the interview.

The Office Action rejects claims 1, 6-7, 51, 53-56 and 59-60 under the judicially created doctrine of obviousness-type double patenting over U.S. Application Publication No. 2004-0042374 to Horimai. A Terminal Disclaimer filed herewith obviates this grounds of rejection. Accordingly, Applicant respectfully requests that the obviousness-type double patenting rejection of the claims be withdrawn.

The Office Action rejects claims 1, 6, 51 and 53-55 under 35 U.S.C. §103(a) over U.S. Patent No. 5,719,691 to Curtis et al. (hereinafter "Curtis") in view of U.S. Patent No. 5,856,048 to Tahara et al. (hereinafter "Tahara"). This rejection is respectfully traversed.

As discussed during the personal interview, Applicant submits that the combination of references is not proper since the references are combined: 1) without indicating any valid reason in the prior art to combine; 2) with hindsight consideration of the present application; and 3) by picking and choosing elements of the prior art without viewing the disclosure of the cited references as a whole.

There is no motivation provided by any of the prior art references for making the proposed modification. The only motivation for making the proposed modification of the prior art references is set forth in Applicant's disclosure, the consideration of which constitutes impermissible use of hindsight.

The Office Action picks and chooses elements from the prior art, without reviewing the references or the claimed subject matter as a whole, and without considering the context of the elements in the prior art reference. For example, the Office Action asserts that it would have been obvious to modify the structure of Curtis to add the reflective layer of Tahara. However, the structure of Curtis would be incompatible with the reflective layer of Tahara, because the diffraction pattern occurring between the incident reference beam 11 and object beam 26 would be distorted by the presence of the reflected beam within the holographic medium 13. Therefore, the hologram formed on the holographic medium 13 would be modified by the reflected light, and there is no teaching in Curtis or Tahara as to what effects this additional reflected light would cause or even if it is operative in this situation. Thus, the combination is purely speculative, and one of ordinary skill in the art would not have been motivated to combine Tahara with Curtis.

Furthermore, the reproduction light is generated in the holographic medium, and is transmitted through the medium 13 to the detector 22, which is located on the opposite side of holographic medium 13 from the object beam 26 and reference beam 11. Therefore, since the detector is located on the opposite side of the holographic medium 13, the medium must be transparent in order for the reproduction light to reach the detector 22. Therefore, by including the reflective film of Tahara, none of the reproduced light would reach the detector, and Curtis would be rendered inoperable.

Thus, it is respectfully submitted that there is no motivation in any of the references of record for modifying or combining their structures. Thus, the Office Action has failed to make out a case of *prima facie* obviousness. Accordingly, Applicant respectfully submits that the rejection of claims 1, 6, 51 and 53-55 under 35 U.S.C. §103(a) is improper and should be withdrawn.

The Office Action rejects claims 7, 16, 56, 59-60, 79-80 and 82 under 35 U.S.C. §103(a) over Curtis in view of Tahara, further in view of U.S. Patent No. 3,573,362 to Burchardt and U.S. Patent No. 6,272,095 to Liu et al. (hereinafter "Liu"). This rejection is respectfully traversed.

As discussed above, one of ordinary skill in the art would not have been motivated to combine Curtis and Tahara. As discussed during the personal interview, Applicant respectfully submits that one of ordinary skill in the art would also not have been motivated to combine Tahara with Burchardt and Liu. Similar to Curtis, both Burchardt and Liu also use a transparent recording medium, in which a diffraction pattern arises from interference between two beams. Should a reflective layer be added to the recording medium, the diffraction pattern would be distorted by the presence of the reflected light, and the recorded pattern would be different from that without the reflective layer. Neither Burchardt nor Liu teach what effects this additional reflected light would cause, or even if the device is operable.

Further, both Burchardt and Liu teach to place the detector on an opposite side of the recording medium to retrieve the recorded information. However, Tahara's reflective layer renders the Liu and Burchardt detector completely inoperable, and there is no teaching or suggestion of how to retrieve the information in this situation.

Thus, it is respectfully submitted that one of ordinary skill in the art would not have been motivated by any of the references of record to modify or combine their structures. Thus, the Office Action has failed to make out a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that the rejection of claims 7, 16, 56, 59-60, 79-80 and 82 under 35 U.S.C. §103(a) be withdrawn.

The Office Action rejects claims 2, 8, 17, 52 and 58 under 35 U.S.C. §103(a) over Curtis, Burchardt and Liu and further in view of either U.S. Patent No. 4,638,471 to Von

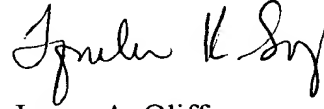
Rosmalen, U.S. Patent No. 4,213,193 to Reid et al. (hereinafter "Reid") or U.S. Patent No. 5,777,760 to Hays et al. (hereinafter "Hays"); and rejects claims 81 and 83-85 under 35 U.S.C. §103(a) over Curtis, Burchardt and Liu and further in view of Reid. Applicant respectfully traverses these rejections.

Specifically, Applicant submits that neither Von Rosmalen, Hays nor Reid remedy the deficiencies of Curtis, Burchardt or Liu as discussed above, because none of Von Rosmalen, Reid or Hays discloses or suggests an information recording medium having a reflecting layer. Accordingly, Applicant respectfully requests that the rejection of claims 2, 8, 17, 52, 58, 81 and 83-85 under 35 U.S.C. §103(a) be withdrawn.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-2, 6-8, 16-17, 51-56, 58-60, 79-85 and 96 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,



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Attachment:
Terminal Disclaimer

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